



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,602	08/20/2003	Angela C. W. Lai	2500803-900101	5575

7590 12/11/2006
WILLIAM S. FROMMER ESQ.
C/O FROMMER LAWRENCE AND HAUG LLP
745 FIFTH AVENUE
NEW YORK, NY 10151

EXAMINER	
MAI, LAM T	
ART UNIT	PAPER NUMBER
2819	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,602

Applicant(s)

LAI ET AL.

Examiner

LAM T. MAI

Art Unit

2819

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 29-51 and 66-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 12, 15, 29, 44 and 66-69 is/are rejected.
- 7) ☒ Claim(s) 2-11, 13, 14, 16-24, 30-43 and 45-51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/2003</u> <u>5/26/06</u> <u>8/11/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 15 is objected to because of the following informalities: an "AND" is missing between limitation before the last limitation. Claim 15 is also missing limitation (e) Appropriate correction is required.

Claim 44 is objected to because of the following informalities: an "AND" is missing between limitation (d) and limitation (e). Appropriate correction is required.

Claim 66 is objected to because of the following informalities: an "AND" is missing between limitation (d) and limitation (e). Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 19 of U.S. Patent No. 6,888,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of inserting a clip and trailer or both into the transcoded media content then transmitting media content including the clip or trailer or both is obvious to one of ordinary skill in the art to incorporate the clip or trailer or both into a media for improving interested of audiences.

Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8 and 18 of U.S. Patent No. 6,888,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of inserting a clip and trailer or both into the transcoded media content then transmitting media content including the clip or trailer or both is obvious to one of ordinary skill in the art to incorporate the clip or trailer or both into a media for improving interested of audiences.

Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,593,860. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of inserting a clip and trailer or both into the transcoded media

content then transmitting media content including the clip or trailer or both is obvious to one of ordinary skill in the art to incorporate the clip or trailer or both into a media for improving interest of audiences.

Claim 15 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,407,680. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of download transcoded media content of the application is similar to receiving transcoded media content of claim 1 of USP 6,407,680, It would be obvious to one of ordinary skill in the art to incorporate features of downloading the transcoded media content.

Claim 29 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,407,680. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of automatically detecting one or more destination format criteria without end user input would be obvious to one of ordinary skill in the art to improve flexibility of end user.

Claim 44 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,888,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of automatically detecting one or more destination format criteria without end user input would be obvious to one of ordinary skill in the art to improve flexibility of end user.

Claim 66 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,888,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of transmitting transcoded media content according to bandwidth criteria supplied to a media content service provider that performs the media content transcoding operation would be obvious to one of ordinary skill in the art to improve transcoding service.

Claim 67 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,888,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of transmitting transcoded media content according to bandwidth criteria selected by a transcoding service that also performs the media content transcoding operation would be obvious to one of ordinary skill in the art to improve transcoding service.

Claim 68 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,888,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of transmitting transcoded media content according to bandwidth criteria supplied to a media content service provider that performs the media content transcoding operation would be obvious to one of ordinary skill in the art to improve transcoding service.

Claim 69 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,888,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because, features of transmitting transcoded media content according to bandwidth criteria selected by a transcoding service that also performs the media content transcoding operation would be obvious to one of ordinary skill in the art to improve transcoding service.

Allowable Subject Matter

Claims 2-11, 13-14, 16-24, 30-43, and 45-51 are objected to as being dependent upon a double patenting rejected base claim, but would be allowable if all the rejected claims are solved.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAM T. MAI whose telephone number is (571)272-1807. The examiner can normally be reached on 5:30 am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Barnie Rexford can be reached on (571) 272-7492. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2819

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lam T. Mai
Art Unit 2819